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09/662,284	09/14/2000	Ken Hayward	D990171	9833

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EXAMINER

FADOK, MARK A

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/662,284

Applicant(s)

HAYWARD ET AL.

Examiner

Mark A Fadok

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 September 0200 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected under the judicially created doctrine of double patenting over the claims and specification of copending Application No. 09/397,126. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Both application deal with replacement of parts on computer peripherals using sensing devices and remote monitoring techniques.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-12, 14-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaygeyama (6,333,790).

In regards to claim 1, Kaygeyama discloses a method of ordering a part for a xerographic apparatus comprising: monitoring electronically a condition of a replaceable part in a first device (abstract), the replaceable part having: a first condition upon installation; at least one intermediate condition after use; and a

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third condition when a replacement part is substantially necessary (col. 18, lines 55-67); and electronically sending a signal to a second device (Claim 1), the signal automatically electronically offering to purchase a replaceable part upon identification of at least one of the first condition, second condition, and third condition in the replaceable part using an electronic signature (col. 2, lines 9-67). In regards to claim 2, Kaygeyama teaches predicting a condition of the part prior to the electronically sending the signal (**FIG 10, AVERAGE LIFE TIME**).

In regards to claim 3, Kaygeyama teaches receiving electronically an acceptance of the offer to purchase the replaceable part (Claim 4).

In regards to claim 4, Kaygeyama teaches installing the replaceable part prior to occurrence of the third condition. Kageyama teaches monitoring the life cycle of the replaceable parts and ordering and replacing the parts prior to failure/consumption (**FIG 10**). Therefore, Kageyama teaches installing the replaceable part prior to the occurrence of the third condition.

In regards to claim 5, Kaygeyama teaches delivering the replaceable part to the first device when monitoring indicates the condition of the part is between about the first condition and the third condition (col. 13, lines 7-17).

In regards to claim 6, Kaygeyama teaches providing information relating to the signal to at least one of a user, a supplier, and a third party (col. 10, lines 34-38).

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In regards to claim 7, Kaygeyama teaches wherein the information relates to at least one of: (1) a present condition of the part; (2) a prediction of a future condition of the part; (3) an inquiry; and (4) an offer to purchase (Claim 3).

In regards to claim 8, Kaygeyama teaches using a sensor and software system to perform monitoring and predicting of a condition of the part (col. 10, lines 16-23).

In regards to claim 9, Kaygeyama teaches wherein at least one of the first device and the second device are interactive (**FIG 16**).

In regards to claim 10, Kaygeyama teaches displaying a purchase order screen, the purchase order screen including data relating to the part; and sending the data electronically to a supplier of the part (See response to claim 3. and **FIG 8, Item 1002**)

In regards to claim 11, Kaygeyama teaches sending data to the supplier after a user enters data (**FIG 6, Item 606**).

In regards to claim 12, Kaygeyama teaches wherein the information further relates to at least one of: (1) present supply of a consumable; (2) wear of a consumable; (3) usage of the part; (4) rate of depletion of a consumable; (5) rate of wear of the consumable; (5) predicted date of depletion of the consumable; (5) a predicted date of need of a consumable; (6) delivery schedule of a consumable; and (5) statistical data relating to a part (col. 11, lines 21-29).

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In regards to claim 14, Kaygeyama discloses a method of ordering a part for an apparatus comprising: identifying electronically a condition in an apparatus; and automatically launching an electronic communications to initiate at least one of an inquiry and an offer to purchase from a supplier based on the condition. (See response to claim 1 and abstract)

In regards to claim 15, Kaygeyama discloses a method of ordering a part for a marking device comprising: sensing a condition at a consumable part in the marking device, the marking device adapted to at least one of identify and predict a code indicative of a threshold of a consumable (**FIG 12**); and launching an electronic communication to access a computer at an address defined by the condition for ordering a replacement for the consumable part (see response to claim 10).

In regards to claim 16, Kaygeyama discloses a method of ordering a part of claim 15 wherein the consumable part is functionally associated with a sensor and software system to sense and predict a condition in the device and to electronically communicate information, the sensor and software system including logic adapted to initiate a purchase order defined by the condition (**FIG 8**).

In regards to claim 17, Kaygeyama discloses a method of ordering a part for an imaging apparatus comprising: identifying electronically a condition in a

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consumable part (Claim 1), the consumable part including at least one of an ink cartridge, toner cartridge, photoreceptor cartridge, paper, and print head (col. 8, lines 1-20), the consumable part having a first condition upon installation, at least one intermediate condition after use, and a third condition when a replacement of the consumable part is substantially necessary (see response to claim 1); and using a software and sensor system associated with the apparatus for at least one of: (a) electronic monitoring of the condition of the consumable part; (b) electronic predicting of the condition of the consumable part (see response to claim 8); and after at least one of (a) and (b); (c) automatically launching an electronic communications to initiate at least one of an inquiry and an offer to purchase a replacement for the consumable part at an occurrence or prediction of at least one of the first condition, intermediate condition, and third condition (col. 2, lines 9-67).

In regards to claim 18, Kaygeyama teaches receiving electronically an acceptance of the offer to purchase (col. 3, lines 4-12).

In regards to claim 19, Kaygeyama teaches wherein the communication further relates to at least one of: (1) present supply of a consumable; (2) wear of a consumable; (3) usage of the part; (4) rate of depletion of a consumable; (5) rate of wear of the consumable; (5) predicted date of depletion of the consumable; (5)

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a predicted date of need of a consumable; (6) delivery schedule of a consumable; and (5) statistical data relating to a part (FIG 10 and 12).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama, and further in view of M2 PRESSWIRE.

In regards to claim 13 and 20, Kaygeyama teaches launching a communications link to access a URL address, the URL address defined by a condition of the part. Kageyama teaches a communications link over a network conveying information on the condition of the replaceable part, but does not specifically mention launching a link to a manufacturers URL. M2 PRESSWIRE teaches "MarkVision gives "Direct access to the HTML setup pages of print servers from Lexmark, Xerox and Tektronix." (Page 1). It would be obvious to a person of ordinary skill in the art to include in Kaygeyama a link to manufacturers URL's as taught by M2 PRESSWIRE, because in order for a link to be established

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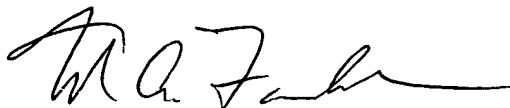
between the manufacturer and the peripheral device an address would need to be established and one of the quickest way to do this is to use a predesignated link to the manufacturers URL.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Fadok whose telephone number is (703) 605-4252. The examiner can normally be reached on Monday to Friday 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Mark Fadok
March 22, 2002



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